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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,849	11/12/2003	Barnaby Henderson	05-03-008	6081
45113	7590	01/26/2007		
DOCKET CLERK PO BOX 800889 DALLAS, TX 75380			EXAMINER KENDALL, CHUCK O	
			ART UNIT	PAPER NUMBER
			2192	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/706,849

Applicant(s)

HENDERSON ET AL.

Examiner

Chuck O. Kendall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Detailed Action**

1. This is in response to application filed 10/02/06.
2. Claims 1 – 22 are still pending.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16 – 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claims 16 – 22, Applicant draws claims to a program product embodied in a machine-readable medium. However, in Applicant's specification on page, 14 paragraph [0048] Applicant discloses that his machine readable medium includes signal bearing media/transmission media. Based on the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility it is disclosed that,

"Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101"

Therefore, since the claims are drawn to a signal or form of energy, claims 16 –22, are non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preisler et al. USPN 5,675,803 B1.

Regarding claims 1, 9 and 16 Preisler discloses a method, (a system and a computer program product) for identifying defective program code, comprising:

providing a first program code having a plurality of verified program components and a second program code having a plurality of modified program components (5:1 – 5, see valid memory address for program, also see 4:40 – 45, see source code file containing edit corrections). Preisler doesn't expressly disclose creating a third program code corresponding to the second program code, wherein one of the modified program components is replaced with a corresponding one of the verified program components testing the third program code; and designating the replaced modified program component as defective according to the results of the test.

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However, Buban in an analogous art and similar configuration discloses a hotpatch and a cold patch which corresponds to each other and features replacement of erroneous code using hot-patchable fixes (0040). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Preisler and Buban because, it would enable fixing the erroneous code dynamically (Buban, 0009).

Regarding claims 2, 10 and 17 the method of claim 1, wherein the first program code, the second program code, and the third program code are dynamic link libraries (Preisler, 33:30 – 31, see linking said dynamic library).

Regarding claims 3, 11 and 18 the method of claim 1, further comprising testing the first program code and the second program code (Preisler, FIG. 5, shows debugging being performed on source and new source file).

Regarding claim 4 the method of claim 1, wherein the creating and designating are repeated for each modified program component in the second program code (Preisler, FIG. 5, shows the process is being repeated after recompiling the source, also see hotpatch and cold patch (Buban, 0010).

Regarding claims 5, 12 and 19 the method of claim 1, wherein the modified program components are program modules (Preisler, 5:20 – 25, see *program* for modules).

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Regarding claims 6, 13 and 20 the method of claim 1, wherein the modified program components are sets of program files developed by the same individual (Presisler, 5:20 – 25, see “instrumented program”).

Regarding claims 7, 14 and 21 the method of claim 1, wherein the modified program components are program files (Presisler, 5:20 – 25, see program).

Regarding claims 8, 15 and 22 the method of claim 1, wherein the replaced modified program component is designated as defective if the test is passed (Buban, 0040).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 – 22 have been considered but are moot in view of the new ground(s) of rejection.

### **Correspondence information**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Kendall whose telephone number is 571-272-3698. The examiner can normally be reached on 10:00 am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 571-272-3695. The fax

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phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ck.

A handwritten signature in black ink, consisting of several loops and a vertical line, located on the left side of the page.

6/21/07